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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/685,750

10/15/2003

Mark Budzik

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01/06/2009

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER
500 W. MADISON STREET
SUITE 3800
CHICAGO, IL 60661

EXAMINER

SPAHN, GAY

ART UNIT

PAPER NUMBER

3635

MAIL DATE

DELIVERY MODE

01/06/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/685,750	Applicant(s) BUDZIK, MARK	
	Examiner Gay Ann Spahn	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 11-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 rejected under 35 U.S.C. 103(a) as being unpatentable over KOENIG, JR. ET AL. (U.S. Patent Application Publication No. 2002/0134035) in view of either ANSTADT ET AL. (U.S. Patent No. 4,141,944) or APPLICANT'S ADMISSION (see Applicant's specification, page 2, line 22 through page 3, line 4 and see also attached Business Journal article entitled "New Building Products Enter Regional Market" which dates Azek™ to at least July 25, 2003 and one page of Azek™ website which dates Azek™ beadboard discussed in specification as far back as July 18, 2002 by internet archive Wayback Machine page attached to Office Action of 07 July 2008).

As to claims 1, 3, 5, and 7, KOENIG, JR. ET AL. discloses a drywall-trimming accessory (10 in Fig. 1) having

either a flange (either of 30, 30) or two diverging flanges (30, 30),

the single flange (either of 30, 30) has or the two diverging flanges (30, 30) have two expansive surfaces (top and bottom surface of each of 30, 30) facing oppositely,

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wherein the drywall-trimming accessory (10) is made of a polymeric material such as polyvinyl chloride (see the first sentence of paragraph no. [0011]).

KOENIG, JR. ET AL. fails to explicitly disclose that the drywall-trimming accessory is made from a cellular polymer, wherein any one of: (1) at least part of at least one of the expansive surfaces of the flange is characterized by open cells of the cellular polymer; (2) at least part of each expansive surface of the flange is characterized by open cells of the cellular polymer; (3) at least part of at least one of the expansive surfaces of each flange is characterized by open cells of the cellular polymer; and (4) at least part of each expansive surface of each flange is characterized by open cells of the cellular polymer.

ANSTADT ET AL. discloses an imitation wood workpiece or board (see Figs. 1 and 2) having an expanded or foamed cellular plastic core (1), wherein “relief embossing causes pores located in the vicinity of the texture furrows to break open outwardly; consequently, the surfaces at the bottom and the flanks of the texture furrows are more or less porous and rough” (see col. 2, lines 63-67). In addition, at col. 4, lines 17-20, it states that “[a] desirably extensive irregularity of these ridges can be promoted through the breaking open of the foaming-agent containing pores in the ridges.”

APPLICANT'S ADMISSION (and the supporting documentation of the Business Journal article entitled “New Building Products Enter Regional Market” which dates AzekTM to at least July 25, 2003 and one page of AzekTM website which dates AzekTM beadboard discussed in specification as far back as July 18, 2002 by internet archive

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Wayback Machine page attached to Office Action of 07 July 2008) discloses that it is well known in the art to use AZEKTM beadboard as a building or trimming product which is made of cellular polyvinyl chloride, wherein at its cut edges and where such beadboard has been grooved, as by milling, open cells are visible, at least under low-power magnification via a jeweler's or watchmaker's loupe.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the trimming accessory of KOENIG, JR. ET AL. by making the trimming accessory be made from a cellular polymer, wherein at least part of at least one expansive surface or both of the expansive surfaces of at least one flange or both flanges is characterized by open cells of the cellular polymer as taught by either ANSTADT ET AL. or APPLICANT'S ADMISSION in order for the open cells of the expansive surfaces to better absorb and adhere drywall compound that is to be applied onto the expansive surfaces.

As to claims 2, 4, 6, and 8, KOENIG, JR. ET AL. in view of either ANSTADT ET AL. or APPLICANT'S ADMISSION disclose the drywall-trimming accessory of claims 1, 3, 5, and 7, respectively, as discussed above, and the resulting drywall-trimming accessory from the combination of KOENIG, JR. ET AL. in view of either ANSTADT ET AL. or APPLICANT'S ADMISSION also discloses that drywall-finishing compound is to be applied to at least one of the expansive surfaces or both expansive surfaces of at least one flange (30 of KOENIG, JR. ET AL.) or both the flanges (30, 30 of KOENIG, JR. ET AL.) and the drywall-finishing compound would clearly penetrate the open cells of the expansive surfaces of the flanges of the resulting trimming accessory from the

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combination of KOENIG, JR. ET AL. in view of either ANSTADT ET AL. or APPLICANT'S ADMISSION because it is notoriously well known that open-celled polymers or plastics are absorbent in order to absorb moisture, adhesives, paint, etc.

As to claim 9, KOENIG, JR. ET AL. in view of in view of either ANSTADT ET AL. or APPLICANT'S ADMISSION disclose the drywall-trimming accessory of any one of claims 1 through 8 as discussed above, and the resulting drywall-trimming accessory from the combination of KOENIG, JR. ET AL. in view of either ANSTADT ET AL. or APPLICANT'S ADMISSION also disclose that the trimming accessory is an elongate strip (see Fig. 1 of KOENIG, JR. ET AL. which clearly shows that the trimming accessory is an elongate strip).

As to claim 10, KOENIG, JR. ET AL. in view of either ANSTADT ET AL. or APPLICANT'S ADMISSION disclose the drywall-trimming accessory of claim 9 as discussed above, and the resulting drywall-trimming accessory from the combination of KOENIG, JR. ET AL. in view of either ANSTADT ET AL. or APPLICANT'S ADMISSION also discloses wherein the cellular polymer is polyvinyl chloride (see col. 2, line 41 of ANSTADT ET AL. or page 2, line 24 of APPLICANT'S ADMISSION).

Response to Arguments

Applicant's arguments filed 14 October 2008 have been fully considered but they are not persuasive.

In the "Remarks" section of "Amendment A" filed on 14 October 2008 on page 9, Applicant argues that the examiner fails to state a prima facie case of obviousness

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because KOENIG, JR. has been improperly modified as the examiner's motivation to combine is not from either modifying reference to ANSTADT ET AL. or APPLICANT'S ADMISSION, but rather is from Applicant's own specification.

The examiner disagrees that she has not present a prima facie case of obviousness or that KOENIG, JR. has been improperly modified since the examiner's motivation to combine need not come from either of the modifying references, but can be gleaned from the general knowledge within the art. Therefore, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner notes that it is notoriously well known in the art that open-celled foams are absorbent and that exposing such open cells on a surface would allow enhanced attachment/absorption of any drywall, paint, adhesive, etc. It would be well within the knowledge of the ordinary skilled artisan to remove a layer of the cellular polymer to expose or open the cells on the surface thereof so that the material of the expansive surface of the flange would be absorbent and could attach/absorb drywall, paint, adhesive or other "wet" material to be applied to the surface.

Additionally, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Again the examiner notes that her motivation to combine comes from the general knowledge within the art (i.e., that exposing open cells on the surface of a foam material would allow enhanced attachment/absorption of any drywall, paint, adhesive, etc. to be applied to that surface) and does not include knowledge gleaned only from Applicant's specification.

Based on the foregoing, the examiner is maintaining her 35 U.S.C. 103(a) rejection of claims 1-10 as set forth in the Office Action mailed 07 July 2008.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gay Ann Spahn whose telephone number is (571)272-7731. The examiner can normally be reached on Monday through Friday, 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard E. Chilcot can be reached on (571)-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gay Ann Spahn/
Gay Ann Spahn, Primary Examiner
January 3, 2009